

REMARKS

Applicant thanks the Examiner, Ms. Jila M. Mohandesi, for her courtesies extended to their representative during the telephonic interview conducted on October 22, 2007, and for her assistance in furthering prosecution on the merits of the instant application. During the telephonic interview, independent claim 1 was discussed. However, no agreement with respect to patentability of the claims over the prior art was reached. The following comments expand on the subject matter discussed during the telephonic interview.

Claims 1, 3-12, 14-18, and 20 are pending in this application, with claims 1, 14, and 18 being the only independent claims. Claims 1, 14 and 18 have been amended. Support for the above amendments may be found, for example, in Fig. 5; and at paragraph [0036] of the specification as originally filed. No new matter has been added. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Independent claim 1 is amended to recite “at least two different ones of said artificial fingernails in a position substantially perpendicular to said bottom surface comprising a holding material having slits in which said at least two of said artificial fingernails are respectively received, said means for retaining being configured to hold said artificial fingernail in a position substantially perpendicular to said bottom surface such that one of the longitudinal ends of each of said at least two of said artificial fingernails faces said front of said package”.

Independent claim 14 is amended to recite “said at least two artificial fingernails being arranged substantially perpendicularly to said bottom surface such that one of the opposing longitudinal ends of each of said at least two artificial fingernails faces said front of said package”.

Independent claim 18 is amended to recite “said holding material having slits in which said at least two of said artificial fingernails are arranged substantially perpendicularly to said bottom surface such that one of said longitudinal ends of each of said at least two of said artificial fingernails faces a front of said package”.

Support for the above amendments to independent claims 1, 14, and 18 may be found, for example, in Fig. 5; and at paragraph [0036] of the specification as originally filed. No new matter has been added.

Claims 1, 3-5, 9-18, and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,791,482 (“*Murphy*”) in view of U.S. Patent No. 4,282,975 (“*Ovadia*”).

Claims 6-8 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Murphy* in view of U.S. Patent No. 4,106,614 (“*Aylott*”).

None of the references, alone or in combination, teach or suggest that one of the longitudinal ends of each of said at least two of said artificial fingernails is arranged substantially perpendicularly to said bottom surface and faces said transparent portion on the front of said package, as now required by each of the independent claims 1, 14, and 18.

Both *Murphy* and *Aylott* disclose an artificial nail package in which the tops of the artificial nails face the front of the package and the longitudinal ends of the nails face the sides of the package (see Fig. 1 of *Murphy*; and Figs. 1-2 of *Aylott*). Neither *Murphy* nor *Aylott* provide any motivation for arranging the fingernail substantially perpendicularly to the bottom surface of the package so that the longitudinal end of the artificial nail faces the front of the package. In contrast, both *Murphy* and *Aylott* tout the advantages of showcasing the top of the nails through the front of the package (see col. 4, lines 1-12 of *Murphy*; and col. 2, lines 24-28 of *Aylott*). *Murphy* and *Aylott* thus teach away from such a claimed arrangement.

Ovadia fails to provide any specific teaching regarding the arrangement and/or placement of artificial fingernails in a display package. *Ovadia* relates to the display of jewelry and discloses that a slit may be used to hold jewelry, i.e., a ring, which is to be displayed. More specifically, *Ovadia* teaches a holder for a ring display with a slit arranged to hold the ring so that a top of the ring is showcased to a customer. Since *Ovadia* discloses a holder for a ring, the arrangement of *Ovadia* fails to teach or suggest or provide any reason to hold artificial fingernails in a manner so as to showcase the longitudinal ends of the artificial nails through the front of an artificial nail package. Only the present application teaches the advantages of arranging the longitudinal end of the artificial nail at a position substantially perpendicular to the bottom surface of the package such that a user is permitted to easily and effectively examine and compare several features of the included nails through the front of the package to determine whether they are well suited for the user's natural fingernails.

The Examiner (pg. 3) asserts that:

The way the artificial nails are arranged in the holding material ... would be a design choice depending on the size of the size and shape of the artificial nails and the holding material.

Applicant does not agree.

As described at paragraph [0040] of the specification as originally filed:

because the c-curve of artificial nails 521 and 522 are directly viewable as a result of the manner of placement of artificial nails 521 and 522 in curvature-displaying compartment 540, the respective arch heights of the artificial nails 521 and 522 located in curvature-displaying compartment 540 may be directly viewed and compared by the user to the arch heights of the user's natural fingernails. In this manner, the user is able to make a more informed decision regarding the suitability for the user's natural fingernails of the enclosed artificial nails 521 and 522 located within package 610.

It is thus clear applicants have provided a specific purpose for arranging the longitudinal end of the artificial nail through the front of the package at a position substantially perpendicular

to the bottom surface of the package. In fact, there is a criticality associated with the specific perpendicular arrangement of the nail, which is more than just a design choice, i.e., for the purpose of permitting a user to easily and effectively examine and compare several features of the included nails to determine whether they are well suited for the user's natural fingernails.

Moreover, the MPEP 2141.02 states:

[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103. *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). However, "discovery of the cause of a problem ... does not always result in a patentable invention.... [A] different situation exists where the solution is obvious from prior art which contains the same solution for a similar problem." *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (emphasis in original).

Therefore, without knowledge of the problem that the claimed invention seeks to solve, the skilled person would be oblivious to the final solution that is achieved by the structure recited in each of now amended claims 1, 14, and 18.

Murphy, Ovadia and Aylott, individually or in combination, do not disclose or suggest the stated problem which the claimed invention seeks to solve, i.e., permitting a user to easily and effectively examine and compare several features of the included nails through the front of the package to determine whether they are well suited for the user's natural fingernails.

Consequently, it does not follow that the skilled person could achieve a product that would achieve the same result as applicant's claimed package, i.e., at least one of a c-curve and an arch height of each of the at least two different ones of said artificial fingernails is observable outside of the package through the transparent portion on the front of the package of the exterior portion. Therefore, the skilled person seeking to create a package in which the c-curve of a nail could be viewed from the front of the package would have no reason to consider the disclosure of *Ovadia*

and/or *Aylott* when seeking to modify *Murphy* so as to achieve a package that would provide the same synergy between such combined components that would be achieved by each of the recitations of amended claims 1, 14 and 18. *Ovadia* and/or *Aylott* therefore fail to cure the deficiency of *Murphy*, and therefore the combination of *Ovadia* and/or *Aylott* fails to achieve the claimed invention for this additional reason.

Moreover, it would not be “obvious to try” to achieve applicant’s claimed package based on the teachings of the cited art, choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success. Under the guidelines for finding obviousness based on this rationale, articulation of each of the following is now required:

- (1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem;
- (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem;
- (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success¹....

Therefore, if any of the foregoing findings cannot be made, the “obvious to try” rationale cannot be used to support a conclusion that the claimed invention would have been obvious to one of ordinary skill in the art. As stated above, only the present application teaches the advantages of arranging the longitudinal end of the artificial nail through the front of the package at a position substantially perpendicular to the bottom surface of the package, i.e., providing a way for a package in which the c-curve of a nail could be viewed through the front surface of the package.

Murphy, *Ovadia* and *Aylott* provide nothing whatsoever with respect to permitting a user to easily and effectively examine and compare several features of the included nails to determine whether they are well suited for the user’s natural fingernails. Therefore, it is impossible to

¹ See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* Federal Register/Vol. 72, No. 195/Wednesday October 10, 2007 Notices


articulate that there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem or to articulate that there had been a finding that there were a finite number of identified, predictable potential solutions to a recognized need or problem, based on the teachings of the cited art. The rationale that it would have been "obvious to try" therefore cannot be used to support the conclusion that the claim would have been obvious to one of ordinary skill in the art based on the teachings of *Murphy*, *Ovadia* and *Aylott*. The combined disclosures of *Murphy*, *Ovadia* and *Aylott* therefore fails to teach or suggest that "one of the longitudinal ends of each of said at least two of said artificial fingernails is arranged substantially perpendicularly to said bottom surface and faces said transparent portion on the front of said package", and independent claims 1, 14 and 18 are deemed to be allowable.

Dependent claims 3-13, 15-17, and 19-20 are allowable for at least the same reasons as are independent claims 1, 14, and 18, as well as for the additional recitations contained therein.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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Dated: November 26, 2007